



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,574	09/23/2003	Mayuko Okada	501152.20022	3046
7590	04/06/2006		EXAMINER	
Eugene LeDonne Reed Smith, LLP 599 Lexington Avenue, 29th Floor New York, NY 10022			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/668,574	Applicant(s) OKADA ET AL.
	Examiner Callie E. Shosho	Art Unit 1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 13 January 2006.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-12 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 1/13/06.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Koga et al. (U.S. 2003/0073759).

The rejection is adequately set forth in paragraph 5 of the office action mailed 7/13/05 and is incorporated here by reference.

4. Claims 7-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato (U.S. 6,440,203).

The rejection is adequately set forth in paragraph 6 of the office action mailed 7/13/05 and is incorporated here by reference.

5. Claims 7 and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Segawa et al. (U.S. 2004/0024086).

The rejection is adequately set forth in paragraph 7 of the office action mailed 7/13/05 and is incorporated here by reference.

6. Claims 7-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Valentini et al. (U.S. 2005/0020730).

The rejection is adequately set forth in paragraph 8 of the office action mailed 7/13/05 and is incorporated here by reference.

Response to Arguments

7. Applicants' arguments regarding Fujioka et al. (U.S. 5,667,569) and Yatake (U.S. 5,746,818) have been fully considered but they are moot in view of the discontinuation of the use of these references against the present claims.

8. Applicants' arguments filed 1/13/06 have been fully considered but, with the exception of arguments relating to Fujioka et al. and Yatake, they are not persuasive.

Specifically, applicants argue that while all the cited references disclose ink comprising acrylic polymer and tripropylene glycol n-butyl ether or dipropylene glycol n-propyl ether, the acrylic polymer and the tripropylene glycol n-butyl ether or dipropylene glycol n-propyl ether are indiscriminately recited as part of numerous components and that none of the cited references teach or suggest the use of acrylic polymer in combination with the tripropylene glycol n-butyl ether or dipropylene glycol n-propyl ether. Applicants argue that this is especially significant in light of the comparative data set forth in the present specification.

However, with respect to Koga et al., it is noted that paragraph 43 of Koga et al. discloses that it is an "essential feature" of the invention to use polypropylene glycol n-butyl ether having three propylene oxides which is identical to the glycol ether required in present claim 1. Further,

paragraph 28 discloses the use of acrylic polymer dispersant. Although Koga et al. discloses the use of other types of dispersant, applicant's attention is drawn to MPEP 2131.02 (A) which states that "...when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named". *Ex Parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990).

While it is agreed that there are no examples of ink comprising combination of acrylic polymer and tripropylene glycol n-butyl ether, however, "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others", *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). A fair reading of the reference as a whole discloses the use of both acrylic polymer and tripropylene glycol n-butyl ether as presently claimed.

Thus, given that Koga et al. disclose that the use of tripropylene glycol n-butyl ether is an "essential feature" of the ink and given that Koga et al. clearly names acrylic polymer as a dispersant for use in the ink, it is the examiner's position that Koga et al. remains a relevant reference against the present claims under 35 USC 102(e).

With respect to Kato, it is noted that col.5, lines 45-50 of Kato et al. disclose that the use of dispersant derived from acrylic acid is "preferred". Further, it is noted that col.8, lines 2-3 of Kato discloses the use of dipropylene glycol mono-n-propyl ether as presently claimed. Although Kato discloses the use of other types of penetrating agent, applicant's attention is drawn to MPEP 2131.02 (A) which states that "...when the species is clearly named, the species claim is

anticipated no matter how many other species are additionally named". *Ex Parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990).

While it is agreed that there are no examples in Kato of ink comprising combination of acrylic polymer and dipropylene glycol mono-n-propyl ether, however, "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others", *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). A fair reading of Kato et al. as a whole discloses the use of both acrylic polymer and dipropylene glycol mono-n-propyl ether as presently claimed.

Thus, given that Kato discloses that the use of acrylic polymer is "preferred" and given that Kato clearly names dipropylene glycol mono-n-propyl ether as a penetrating agent for use in the ink, it is the examiner's position that Kato remains a relevant reference against the present claims under 35 USC 102(b).

With respect to Segawa et al., it is noted that paragraph 36, lines 19-21 of Segawa et al. disclose that the use of acrylic polymer is "preferred". Further, it is noted that paragraph 65, lines 17-18 of Segawa et al. each disclose the use of dipropylene glycol mono-n-propyl ether as presently claimed. Although Segawa et al. disclose the use of other types of penetrating agent, applicant's attention is drawn to MPEP 2131.02 (A) which states that "..when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named". *Ex Parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990).

While it is agreed that there are no examples in Segawa et al. of ink comprising combination of acrylic polymer and dipropylene glycol mono-n-propyl ether, however,

“applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others”, *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). A fair reading of Segawa et al. as a whole discloses the use of both acrylic polymer and dipropylene glycol mono-n-propyl ether as presently claimed.

Thus, given that Segawa et al. each disclose that the use of acrylic polymer is “preferred” and given that Segawa et al. each clearly names dipropylene glycol mono-n-propyl ether as a penetrating agent for use in the ink, it is the examiner’s position that Segawa et al. remains a relevant reference against the present claims under 35 USC 102(e).

With respect to Valentini et al., it is noted that paragraph 46 of Valentini et al. disclose that the ink contains at least one soluble polymer and that “especially preferred” polymers are those disclosed in U.S. 5,085,698 (Ma et al.). It is noted that Ma et al. requires the use of acrylic polymer, i.e. block polymer obtained from (meth)acrylate and/or (meth)acrylic acid (col.3, line 31-col.4, line 50 and col.5, lines 20-65). Thus, it is clear that “especially preferred” polymers of Valentini et al. are acrylic polymers as presently claimed. Further, it is noted that paragraph 43, line 14 of Valentini et al. disclose the use of dipropylene glycol mono-n-propyl ether as presently claimed. Although Valentini et al. disclose the use of other types of penetrating agent, applicant’s attention is drawn to MPEP 2131.02 (A) which states that “..when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named”. *Ex Parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990).

While it is agreed that there are no examples in Valentini et al. of ink comprising combination of acrylic polymer and dipropylene glycol mono-n-propyl ether, however,

“applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others”, *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). A fair reading of Valentini et al. as a whole discloses the use of both acrylic polymer and dipropylene glycol mono-n-propyl ether as presently claimed.

Thus, given that Valentini et al. each disclose that the use of acrylic polymer is “especially preferred” and given that Valentini et al. each clearly names dipropylene glycol mono-n-propyl ether as a penetrating agent for use in the ink, it is the examiner’s position that Valentini et al. remains a relevant reference against the present claims under 35 USC 102(e).

Applicants also point to the comparative data set forth in the present specification. It is noted that the data compares ink within the scope of the present claims, i.e. comprising acrylic polymer and tripropylene glycol n-butyl ether or acrylic polymer and dipropylene glycol n-propyl ether, with ink outside the scope of the present claims, i.e. comprising no acrylic polymer and tripropylene glycol n-butyl ether, comprising acrylic polymer and no glycol ethers, comprising acrylic polymer and tripropylene glycol methyl ether, comprising acrylic polymer and diethylene glycol diethyl ether, comprising acrylic polymer and triethylene glycol diethyl ether, and comprising triethylene glycol dimethyl ether and salt of copolymer of acrylic acid/sulfonic acid monomer. It is shown that the inks of the present invention are superior in terms of recovery performance, straight travel stability, fixation, and/or drying.

However, as cited in MPEP 706.02(b), it is noted that a rejection based on 35 USC 102(b) can only be overcome by (a) persuasively arguing that the claims are patentably distinguishable from the prior art, (b) amending the claims to patentably distinguish over the

prior art, or (c) perfecting priority under 35 USC 119(e) or 120. As can be seen, comparative data is not sufficient to overcome an anticipatory rejection under 102(b).

Similarly, it is noted that a rejection based on 35 USC 102(e) can only be overcome by (a) persuasively arguing that the claims are patentably distinguishable from the prior art, (b) amending the claims to patentably distinguish over the prior art, (c) filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by “another”, (d) filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, (e) perfecting a claim to priority under 35 U.S.C. 119(a)-(d), or (f) perfecting priority under 35 U.S.C. 119(e) or 120. As can be seen, comparative data is not sufficient to overcome an anticipatory rejection under 102(e).

Further, with respect to Kato, Segawa et al., and Valentini et al., even *if* the data were considered, it is the examiner’s position that the data would not be persuasive given that there is no comparison between ink of the present invention and ink of the “closest” prior art. The comparative examples set forth in the present invention are not only outside the scope of the present claims but also outside the scope of Kato, Segawa et al., and Valentini et al. which do not disclose the use of tripropylene glycol n-butyl ether, tripropylene glycol methyl ether, diethylene glycol diethyl ether, triethylene glycol diethyl ether, or triethylene glycol dimethyl ether and salt of copolymer of acrylic acid/sulfonic acid monomer and which each disclose that the use of acrylic polymer is “preferred”. Thus, even if the declaration were considered with respect to Kato, Segawa et al., and Valentini et al., it is the examiner’s position that the declaration would not be successful in establishing unexpected or surprising results over these references.

Conclusion

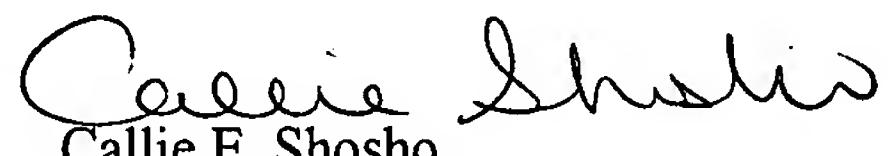
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
3/21/06